



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,619	04/10/2001	Joseph Tesler	1481.007	7991

7590 04/12/2006

Morris E. Cohen  
Suite 217  
1122 Coney Island Avenue  
Brooklyn, NY 11230

EXAMINER

COLILLA, DANIEL JAMES

ART UNIT	PAPER NUMBER
----------	--------------

2854

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/829,619		TESLER, JOSEPH	
	<b>Examiner</b>		<b>Art Unit</b>	
	Daniel J. Colilla		2854	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 21-33 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 21-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

*Prosecution has been reopened in this application due to an error discovered by applicant that was mentioned in the appeal brief filed on 1/23/06.*

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 27 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's disclosure of the prior art in view of Erickson.

With respect to claim 1, applicant's admission of prior art discloses the claimed method except for the automated placement of text with a single movement of the human hand. In applicant's disclosure of the prior art, as outlined in pgs. 4-6, applicant discloses that the requirements for preparing a Jewish religious scroll are known. These requirements include placing text of a Jewish religious scroll onto kosher parchment by hand so that the scroll does not have any defects in each letter and each letter is separated. It is also known, as disclosed by applicant, to prepare a Jewish religious scroll so that no letters touch one another (parent application 09/792,474, paragraph [0015], lines 10-12). Erickson teaches a method for automatically placing text 6 onto a substrate 7 with a squeegee 5 as shown in Figure 3 of Erickson. Additionally, Erickson teaches that the squeegee is used to draw the ink across the screen cloth 2 so that the ink will pass through the open areas of the text 6 leaving a print on the

Art Unit: 2854

workpiece 7 (Erickson, col. 3, lines 44-30). It would have been obvious to combine the teaching of Erickson with applicant's admission of prior art for the advantage of automating the placement of text on a substrate and therefore reducing the time it takes to hand write a document. Furthermore, it would have been obvious to one of ordinary skill in the art to print the text with no defects according to the required level of quality.

With respect to claims 2-5, applicant's admission of prior art discloses that it is known to print a Torah scroll, a Megillah scroll, a Mezzuzah scroll and a Tefillin scroll. It would have been obvious to one of ordinary skill in the art to screen print and desired document in view of the teaching of Erickson.

With respect to claim 6, Erickson teaches a silk screen template 2.

With respect to claim 27, on page 5, lines 10-11, of applicant's disclosure, applicant discloses that crowns on the printed letters are known.

With respect to claim 31, applicant's admission of prior art (parent application, 09/792,474, paragraph 19, lines 3-6) 2, discloses that it is known to recite a blessing and when printing the name of "G-d" on a scroll.

3. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art in view of Erickson, as applied to claims 1-6 above, and further in view of Akhdar *et al.*

With respect to claim 7, applicant's admission of prior art in view of Erickson discloses the claimed method for preparing a Jewish religious scroll except for the step of providing an ultraviolet ink. However, Akhdar *et al.* teaches that it is known in silk screening processes to use

Art Unit: 2854

an ultraviolet ink (paragraph [0129]). It would have been obvious to combine the teaching of Akhdar *et al.* with the method disclosed by applicant's admission of prior art in view of Erickson for the quick curing advantages of ultraviolet of ink.

With respect to claim 8, Akhdar *et al.* further teaches that the ink is water-based (paragraph [0109], lines 1-4). A water based ink is heat sensitive since as the water evaporates from the ink due to application of heat, the ink will dry.

4. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art in view of Erickson, as applied to claims 1-6, 27 and 31 above, and further in view of Dunson.

With respect to claim 8-10, applicant's admission of prior art in view of Erickson discloses the claimed method for preparing a Jewish religious scroll except that it is not known if the ink is heat sensitive. However, Dunson teaches that it is known to use heat sensitive ink in silk screening. In col. 4, lines 17-24, Dunson discloses that the ink is cured by illumination devices 14. It would have been obvious to combine the teaching of Dunson with the method disclosed by applicant's admission of prior art in view of Erickson for the advantage of the safety device for reducing scorch of the substrate being printed (Dunson, col. 3, lines 47-49).

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art in view of Erickson, as applied to claims 1-6, 27 and 31 above, and further in view of Hackett.

Art Unit: 2854

Applicant's admission of prior art in view of Erickson, discloses the claimed method, except that it is not known if the content being reproduced is based on a pre-existing document. However, it is well-known in the silk screening art to reproduce an original image by use of a silk screen (Hackett, pg. 1, paragraph 0004). It would have been obvious to combine the teaching of Hackett with the method disclosed by applicant's admission of prior art in view of Erickson, for the advantage of creating copies of popular works. As mentioned above, there appears to be no unobviousness in the selection of the particular work that is being reproduced.

6. Claims 12, 29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art in view of Erickson, as applied to claims 1-6, 27 and 31 above, and further in view of Libby.

With respect to claim 12, applicant's admission of prior art in view of Erickson, discloses the claimed method except for etching grid lines into the parchment. However, Libby teaches that it is known to emboss a grid pattern in a writing media (Libby, col. 2, lines 40-48). It would have been obvious to combine the teaching of Libby with the method disclosed by applicant's admission of prior art in view of Erickson, for the advantage of using the embossed lines for aiding in layout and alignment of text or images on the media.

With respect to claim 29, applicant's admission of prior art in paragraph [0014] of parent application 09/792,474 discloses that it is known to print the top of each letter in a scroll so that it hangs from sirtut.

Art Unit: 2854

With respect to claim 32, applicant's admission of prior art (parent application, 09/792,474, paragraph 19, lines 3-6), discloses that it is known to recite a blessing and when printing the name of "G-d" on a scroll.

7. Claims 21-22, 26, 28, 30 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's disclosure of the prior art in view of Erickson.

With respect to claim 21, applicant's admission of prior art discloses the claimed method except for the automated placement of text with a single movement of the human hand. In applicant's disclosure of the prior art, as outlined in pgs. 4-6, applicant discloses that the requirements for preparing a Jewish religious scroll are known. These requirements include placing text of a Jewish religious scroll onto kosher parchment by hand so that the scroll does not have any defects in each letter and such that no letters touch another letter on the document. Additionally, applicant discloses on pg. 4, lines 5-6 that it is known to place *sirtut* (horizontal guidelines) on a scroll when printing a Kosher religious text. Erickson teaches a method for automatically placing text 6 onto a substrate 7 with a squeegee 5 as shown in Figure 3 of Erickson. Additionally, Erickson teaches that the squeegee is used to draw the ink across the silk screen cloth 2 so that the ink will pass through the open areas of the text 6 leaving a print on the workpiece 7 (Erickson, col. 3, lines 44-30). It would have been obvious to combine the teaching of Erickson with applicant's admission of prior art for the advantage of automating the placement of text on a substrate and therefore reducing the time it takes to hand write a document. Furthermore, it would have been obvious to one of ordinary skill in the art to print the text with no defects according to the required level of quality.

With respect to claims 22 and 28, on page 5, lines 10-11, of applicant's disclosure, applicant discloses that crowns on the printed letters are known.

With respect to claims 26, the first full paragraph on page 6 of applicant's specification discloses that reciting a blessing and imprinting the name "G-d" has long been a known tradition. *It appears that when using the term "G-d" applicant intends to mean that the actual term being printed in the religious scroll includes an "o" between the "G" and "d" rather than a "-". As the examiner understands it, the term with the "o" is not permitted except when using the name in a religious scroll or prayer and the term "G-d" is used at all other times.*

With respect to claim 30, applicant's admission of prior art in paragraph [0014] of parent application 09/792,474 discloses that it is known to print the top of each letter in a scroll so that it hangs from sirtut.

With respect to claim 33, applicant's admission of prior art in paragraph [0014] of parent application 09/792,474 discloses that it is known to print the top of each letter in a scroll so that it hangs from sirtut. Applicant's admission of prior art (parent application, 09/792,474, paragraph 19, lines 3-6), also discloses that it is known to recite a blessing and when printing the name of "G-d" on a scroll. Additionally, and on page 5, lines 10-11, of applicant's disclosure, applicant discloses that crowns on the printed letters are known.

8. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art in view of Erickson, as applied to claims 1-6, 27 and 31 above, and further in view of Akhdar *et al.*



Art Unit: 2854

With respect to claim 23, applicant's admission of prior art in view of Erickson discloses the claimed method for preparing a Jewish religious scroll except for the step of providing an ultraviolet ink. However, Akhdar *et al.* teaches that it is known in silk screening processes to use an ultraviolet ink (paragraph [0129]). It would have been obvious to combine the teaching of Akhdar *et al.* with the method disclosed by applicant's admission of prior art in view of Erickson for the quick curing advantages of ultraviolet of ink.

With respect to claim 24, Akhdar *et al.* further teaches that the ink is water-based (paragraph [0109], lines 1-4). A water based ink is heat sensitive since as the water evaporates from the ink due to application of heat, the ink will dry.

With respect to claim 25, Akhdar *et al.* teaches ink as mentioned above, and on page 5, lines 10-11, of applicant's disclosure, applicant discloses that crowns on the printed letters are known.

### ***Response to Arguments***

9. Applicant's arguments filed 3/1/2004 have been fully considered but they are not persuasive of any error in the above rejection.

The examiner agrees that Churchwell is not prior art as applicant has argued in the appeal brief filed on 1/23/06. Thus the Churchwell reference has been replaced with the Al-Akhdar *et al.* publication as outlined above.

With respect to applicant's arguments regarding the provisional applications of Hackett and Dunson, the provisional applications of each of these references support the disclosure relied upon in the above rejection. It is noted, however, that there is a typographical error in the Dunson

Art Unit: 2854

patent which inaccurately lists the provisional document as SN 60/138,913. The provisional application is actually SN 60/136,913.

Additionally, the relied upon disclosure of the newly applied Akhdar *et al.* reference is supported by its provisional application.

Applicant may access the provisional applications for viewing and/or printing using the Public PAIR website <http://portal.uspto.gov/external/portal/pair>.

With respect to applicant's argument regarding the co-existence of silk-screening and preparation of Jewish religious scrolls. Although no art has been found in indicating that Jewish religious scrolls have been silk-screened, this does not render the combination novel. In fact the lack of a teaching in one reference is the very reason combination rejections exist. There are most likely thousands if not millions of particular textual documents that have not been silk-screened but would still have been obvious to silk-screen. The combination of the rejection indicates that Jewish religious scrolls are a known document and silk-screening is a known method of printing documents and therefore it would have been obvious to silk-screen Jewish religious scrolls. With respect to applicant's arguments regarding the precise placement of the text, it is a common desire to print a document as perfectly as possible, free from any defects. In reality, there is a limit to the amount of precision that can be had due to economical factors. It would have been obvious to design a system with the amount of precision that is necessary to reach the desired level of perfection of the finished product.

With respect to applicant's argument that there is no evidence of record of silk-screening on animal parchment, it is noted by the examiner that animal parchment is a known printing media and silk-screen printing is a known method of printing. One of ordinary skill in the art

Art Unit: 2854

would recognize this and would be able to use the general knowledge of the art in order to silk-screen on animal parchment.

Additionally, whether the parchment is Kosher or not, does not appear to have any physical effect on the capability of silk-screening on parchment.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 4, 2006



Daniel J. Colilla  
Primary Examiner  
Art Unit 2854